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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/361,478	07/26/1999	J. WALLACE PARCE	CALPP001X1	5568
26541	7590	02/12/2004	EXAMINER	
RITTER, LANG & KAPLAN 12930 SARATOGA AE. SUITE D1 SARATOGA, CA 95070			TSAI, CAROL S W	
			ART UNIT	PAPER NUMBER
			2857	

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/361,478	PARCE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Carol S Tsai	2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 December 2003.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 3-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

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## **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3, 4, 6-15 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent No. 6,366,924 to parce.

With respect to claims 1 and 12, Parce discloses a computer implemented method of controlling an analytical instrument that analyzes microfluidic devices comprising: receiving a sequence of steps, each step specifying at least one well of a microfluidic device, a value indicative of a driving force to be applied to fluid in at least one well and a duration for applying

the driving force specified by the value to the fluid in the at least one well (see Figs. 2 and 3 and col. 11, line 3 to col. 12, line 16); for each step, applying the driving force specified by the value to the fluid in the at least one well (see col. 8, lines 2-47); and scanning fluid as it passes a detection zone in the microfluidic device (see col. 9, lines 1-41).

As to claim 14, Parce also discloses a system, comprising: an instrument (analytical instrument 10 shown on Fig. 1) that controls and analyzes a microfluidic device (microfluidic device 20 shown on Fig. 1); a computer (computer 50 shown on Fig. 1) including a processor and a computer readable medium (fixed disk drive 642, CD-ROM player 644, and CD-ROM 646 shown on Fig. 6), the computer being capable of directing the instrument to apply a driving force to fluid in wells of the microfluidic device (see col. 3, line 48 to col. 4, line 27; and col. 7, lines 56-68); and code stored on the computer readable medium that includes a sequence of steps, each step specifying at least one well of a microfluidic device, a value indicative of the driving force to be applied to fluid in the at least one well and a duration for applying the driving force specified by the value to the fluid in the at least one well (see col. 7, lines 56-68; col. 8, lines 2-47; col. 11, line 3 to col. 12, line 16; and col. 13, line 44 to col. 14, line 28).

As to claims 3 and 4, Parce also discloses a current/voltage to be applied to the fluid in the at least one well (see col. 3, lines 37-46).

As to claim 6, Parce also discloses a pressure to be applied to the fluid in the at least one well (see col. 8, lines 2-10).

As to claims 7-10, Parce also discloses loading a sample to a main channel in the microfluidic device and running the sample through the main channel past the detection zone (see col. 4, line 28 to col. 5, line 13).

As to claims 11, 13, and 15, Parce also discloses the sequence of steps storing on a computer readable medium and the computer readable medium being selected from the group consisting of a memory, hard disk, floppy, CD-ROM, tape, and data signal embodied on a carrier wave (fixed disk drive 642, CD-ROM player 644, and CD-ROM 646 shown on Fig. 6).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parce in view of U. S. Patent No. 6,416,642 to Alajoki et al.

As noted above, Parce discloses the claimed invention, except for a vacuum to be applied to the fluid in the at least one well.

Alajoki et al. teach a vacuum to be applied to the fluid in the at least one well (see col. 9, lines 23-35).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Parce's method to include a vacuum to be applied to the fluid in the at least one well, as taught by Alajoki et al., in order to drive fluid flow.

***Response to Arguments***

6. Applicant's arguments filed 12/15/2003 have been fully considered but they are not persuasive.

Applicants argue that the subject application gets the benefit of the earlier priority date because it is a continuation-in-part of the U. S. Patent No. 6,366,924 and claims a right of priority to its filing date; therefore, U. S. Patent No. 6,366,924 to Parce is not prior art. The Examiner disagrees with Applicants. A continuation-in-part can have an effective filing date of that earlier parent application only for any claims which are fully supported under 35 U.S.C. 112 by the earlier parent application; but a continuation-in-part shall have the effective filing date equal to the filing date of the continuation-in-part if any claims in the continuation-in-part are not supported by the specification and claims of the parent application. See MPEP 706.02. This application is not entitled to the benefit of the filing date of the earlier application, because claim subject matters, "a computer implemented method of controlling an analytical instrument that analyzes microfluidic devices comprising: receiving a sequence of steps, each step specifying at least one well of a microfluidic device, a value indicative of a driving force to be applied to fluid in at least one well and a duration for applying the driving force specified by the value to the fluid in the at least one well; for each step, applying the driving force specified by the value to the fluid in the at least one well; and scanning fluid as it passes a detection zone in the microfluidic device" disclosed in the claimed invention is not disclosed in the parent application.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol S. Tsai whose telephone number is (703) 305-0851. The examiner can normally be reached on Monday-Friday from 7:30 AM to 4:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (703) 308-1677. The fax number for TC 2800 is (703) 308-7382. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2800 receptionist whose telephone number is (703) 308-1782.

In order to reduce pendency and avoid potential delays, Group 2800 is encouraging FAXing of responses to Office actions directly into the Group at (703) 308-7382. This practice

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may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 2800 will be promptly forwarded to the examiner.

Carol S. Tsai

02/04/04



MARC S. HOFF  
SUPERVISORY PATENT EXAMINER  
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